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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/040,539 03/17/98 YOSHIDA

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EXAMINER

TM02/0323

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ART UNIT

PAPER NUMBER

2173

DATE MAILED:

03/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/040,539

Applicant(s)

Yoshida

Examiner

Huynh-Ba

Group Art Unit
2173



☒ Responsive to communication(s) filed on Jan 22, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-7 and 9 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-7 and 9 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

BA HUYNH
PRIMARY EXAMINER

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. The amendments filed on 1/22/01 have been entered into the record.

Claim Rejections - 35 USC § 112

2. Claims 1, 2 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The applicant failed to provide a detailed description of the now claimed limitation “said first sub-screen causing said display indicating frame to be moved within said sub-screen” (Claim 1, lines 11-12, and the similar in claim 2).

Art Rejections

3. Claims 1, 4, 6 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent #5,945,998 (Eick).

Claims 2,3,5,7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent #5,945,998 (Eick), in view of US patent #6,054,990 (Tran).

Claims 1-7, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent #5,930,809 (Middlebrook), in view of US patent #6,054,990 (Tran).

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Rationales for the rejections continue as set forth in paragraphs 9, 10 and 11 of the last Office action.

Response to Arguments

4. Applicant's arguments filed on 1/22/01 have been fully considered but they are not persuasive.

REMARKS:

Claims 1, 4, and 6 in view of Eick: In response to the argument that Eick does not teach the notifying the main window about the movement of the pointing device, this limitation is not clearly recited in claim 1, and is not included in any of claim 4 or 6. Claim 1 only recites "a main screen image window for moving said image data within said main screen in corresponding to *an output representing movement* of a pointing device as notified by said first sub-screen window", thus only an output *representing* the movement, not the movement is being notified. For example, the movement of the pointing device can be determined by the traveled distance of the pointing device, while *the output representing* the movement of the pointing device can be the scrolling of lines of text. Frame 504 of the sub-screen 205 moves corresponding to the movement of the pointing device, thus the movement of frame 504 is an output representing the movement of the pointing device. Image data in the main window moves corresponding to the movement of frame 504 in sub-screen 205, thus the main window is notified about the movement of frame 504

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(representation of movement of the pointing device). Accordingly, Eick's disclosure met the claimed limitation.

Original claim 1, lines 9-13, recites "a main screen for moving said display indicating frame..., said first sub-screen window causing said display indicating frame to be moved within said sub-screen". In response to the 112-2nd rejection, claim 1 is amended to recite that "said first sub-screen causing said display indicating frame to be moved within said sub-screen" (See claim 1, lines 11-12). Thus the applicant took the position that movement of the display indicating frame is caused by the sub-screen, not by the pointing device. However, this limitation is not supported by the specification, which clearly discloses that the movement of the display indicating frame is caused by the pointing device, i.e., "By dragging the view frame (with the left button of the mouse held depressed within the view frame 60) in the central sub-screen 51 through the same page,...". The specification, page 16, lines 10-13. Thus it appears that the applicant has failed to set forth the subject matter which applicant regards as the applicant's invention as disclosed in the specification. The applicant's comment on Eick's teaching that movement of indicating frame 504 is caused by attachment and movement of a cursor is noted and appreciated. In view of the comment, the limitation when read in light of the applicant's specification, is disclosed by Eick. In case of the applicant continue to press on that the limitation "said first sub-screen causing said display indicating frame to be moved within said sub-screen" must be met, it should be note that it has been discussed that Eick's frame 504 can only be dragged within a sub-screen, not from sub-screen to sub-screen. Thus it is implicitly included

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that the sub-screen has means for causing the frame 504 to move only within the boundary of the sub-screen.

In response to the argument that Eick does not suggest that the sub-screen 205 represents pages of text, the suggestion can be found Eick's teaching of editing text document (page) in column 21, line 25 - col. 22, line 61.

In response to the argument that implementation of smaller size indicating frame is not an obvious design choice, citing that Eick's frame 504 need not to be moved horizontally, this function is not recited in the claim. It has been held that changing in size is an obvious design preference (In re Rose, 105 USPQ 237 (CCPA 1955)).

In response to the argument that Middlebrook does not teach multiple, sub-screen windows, it should be noted that claim 1 does not require the windows to be separated. Nevertheless, Middlebrook's document map 300 (figure 7) comprises a plurality of separated windows. Furthermore, figure 3 discloses a document having a plurality of pages P1, P2, ...P6 with delimiters separating each page. Figure 3 is functionally equivalent to the applicant's plurality of windows representing pages of a document.

In response to the argument that Middlebrook's icon 48 is not for selecting an area of image data, icon 48 is for selecting an area of text 32 to be displayed on the main screen. When icon 48 is moved to the first paragraph of the document, an area of text containing the first paragraph is selected and displayed on the main screen. Picture 46 can be selected and displayed on the main screen by moving icon 48 to the picture (col. 4, lines 5-16). It is noted in figure 2

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that when icon 48 is moved to paragraph 43, an area of text including paragraph 43 and adjacent paragraphs is selected and displayed. Thus icon 48 is functionally equivalent to the selection frame of the claimed invention. In light of the reasoning, it would have been obvious to one of ordinary skill in the art to combine Tran's selection frame 106" to Middlebrook's teaching of selecting an area to display. Motivation of the combining is for providing a visual indication of the selected image data area. Furthermore, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquires

Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231. If applicant desires to fax a response, (703) 308-9051 may be used for formal communications or (703) 308-6606 for informal or draft communications. NOTE: A Request for Continuation (Rule 60 or 62) cannot be faxed.

Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huynh-Ba whose telephone number is (703) 305-9794. The examiner can normally be reached on Monday-Friday from 8.00AM to 4.30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (703) 308-3116.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

Huynh-Ba
Primary Examiner
Art Unit 2173
3/12/01

BA HUYNH
PRIMARY EXAMINER